

S/N 08/970,258

Page 2

C4 At page 5, line ¹⁸16, please insert -[referred to herein as "historical game performance data" or "historical performance data"] after "performance history".

REMARKS**35 U.S.C. §112**

The Examiner rejected claims 1-8 and 16-18 for containing subject matter that was not described in the specification to reasonably convey that the applicant possessed the claimed invention.

Applicant traverses this rejection. In addition to the passage cited by the examiner (page 5, lines 6-8), Applicant notes that original claim 20 states "the personalized information comprises a user age, . . . prohibiting the operation of a video game based upon the user age."

Clearly Applicant reasonably conveyed to one skilled in the art that operation of a game can be prohibited and conversely authorized in response to the age data. Because claim 20 appears to have been overlooked, Applicant has copied the basic language from original claim 20 into the specification, as set forth above. Further, the specification is very clear that the processor uses the personalized information. Thus, the prohibition/authorization is performed by the processor.

The Examiner also rejected claims 1-18 under 35 USC §112, first paragraph.

Applicant traverses this rejection. It appears that the Examiner is analyzing the specification for a commercial embodiment, and rejecting the claims based on a lack of such teaching.

First, the Examiner states that the specification does not describe how the personalized data is input to the controller. The specification teaches that the controller includes a memory, see page 4, line 26 to page 5, line 1. Those skilled in the art will recognize that numerous methods can be used to load the personalized data. For example, the controller includes a receiver 142 that can be used to input the data. Thus, the Examiner's rejection is based on a desire to see a commercial embodiment described. A specific method of loading the controller memory is not required to appreciate or practice the invention.

17 C

S/N 08/970,258
Page 3

Second, the Examiner stated that the specification does not explain how the CPU updates information or a communication protocol. Applicant notes that the CPU includes a transmitter 140. A specific commercial implemented communication protocol is not considered outside the skill of a practitioner in the art. Applicant notes that the specification teaches two possible communication methods; infrared and frequency modulation, page 4, lines 22-23.

The Examiner also states that the specification does not teach where software resides to control the communication, and such information is required to operate the invention as claimed. Applicant notes that such information is not unique to the present invention. Software for operating the CPU is well known in the art. Further, Applicant taught control 138 in the game and control circuit 136 in the controller. Those skilled in the art will appreciate that software is often used by controllers to define specific control parameters and responses.

The Examiner states that the specification does not teach how game authorization or prohibition is performed based on a user's age. Applicant does not understand what level of "those skilled in the art" is being used by the Examiner. The specification clearly teaches that the personalized information can include age data. This data is used by the game controller. Further, original claim 20 and the specification teaches that game operation can be prohibited in response to the age data. Even one of nominal skill would understand that the controller compares the age data to a threshold age for a specific game being executed, and determine authorization. Applicant is not required to teach all possible embodiments to meet the requirements of 35 USC §112.

To assist the Examiner, Applicant notes that it is common to see a label on games, toys, movies and the like a phrase similar to "appropriate for ages X and above". Thus, a commercial embodiment of the present invention could have the game threshold value provided by the game manufacture such that the game controller can compare the user's age to the threshold.

The Examiner states that the language of claim 3 is not supported by the specification. Specifically, the Examiner did not see support for the language teaching that the processor retrieves user information in response to an identification signal. Applicant notes page 5, lines 10-19 supports this language.

C

S/N 08/970,258

Page 4

Applicant traverses the Examiners statement that the specification "only tells half of the story." The other half of the story that the Examiner seeks is actually the next book. It appears that the Examiner wants a detail of all changes that may be needed to current commercial game products. This is not a requirement under 35 USC §112. Applicant notes that the purpose of the U.S. patent system is to encourage the public to build upon the teaching in patents. The adaptation of a patent to commercial products is a natural building process and not "undue experimentation." Applicant has fully supported the present claims as required by 35 USC §112, first and second paragraph.

Finally, the Examiner objected to the specification for not providing antecedent basis for "historical game performance data", "historical performance data" and "video game operating preferences". Applicant has amended the specification to provide antecedent basis.

35 U.S.C. § 103

The Examiner has maintained the substantive rejection from prior actions. Applicant has fully responded to this single reference rejection during prosecution and in the Appeal Brief.

Applicant has not argued that the Lemelson is non-analogous art. Applicant has clearly set forth that the reference does not teach the claim limitations. A student identifier is not an age of the user. The Examiner maintains that the user can be identified by age. First, what if each student in the classroom were the same age? Second, Lemelson teaches that the student identification is used to determine who presented specific answers. The reference is completely absent of any teaching or suggestion of the use of age data to authorize, prohibit or adjust a game.

CONCLUSION

Applicant maintains that the pending claims are in condition for allowance. Because the present application has been pending for over three years, Applicant requests

C

S/N 08/970,258
Page 5

that the Examiner assist by quickly providing either a notice of allowance or a Final Office Action so that Applicant can proceed with the appeal.

Respectfully submitted,

Date: 2/5/01

By: 

Russell D. Slifer
Reg. No. 39,838

Fogg, Slifer & Polglaze, P. A.
P. O. Box 5581009
Minneapolis, Minnesota 55458-1009
Telephone (612) 252-0014
FAX: (612) 252-0019